

In view of the herein contained amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection together with an indication of the allowability of all the claims in the present application, in due course. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant wishes to thank the Examiner for acknowledging the claim of foreign priority under 35 U.S.C. § 119 as well as for confirming receipt of the certified copies of the priority documents in support of Applicant's Claim for Priority.

Additionally, Applicant respectfully thanks the Examiner for considering the documents listed in the various Information Disclosure Statements filed in the present application and for confirmation of such consideration by return of the initialed and signed PTO-1449 Forms attached to the respective Information Disclosure Statements.

Moreover, Applicant notes the filing of yet a further Supplemental Information Disclosure Statement on March 17, 2003 (shortly after the issuance of the outstanding Official Action). Applicant respectfully requests that the Examiner consider each of the documents cited therein and confirm such consideration by again returning a copy of the signed and initialed PTO-1449 Form that accompanied the above Supplemental Information Disclosure Statement.

Applicant notes the Examiner's indication regarding the objection to the drawing by the Draftsman. Concurrently with the filing of the present Response, Applicant is filing

formal versions of Figs. 5 and 8 (the only figures objected to by the Draftsman) with the noted informalities eliminated.

In the outstanding Official Action, the Examiner set forth a restriction between Groups I, comprising claims 20-31 and 39-49, and Group II comprising claims 32-38 and 50-56. The Examiner noted a provisional election with traverse of the invention of Group I comprising claims 20-31 and 39-49. Applicant hereby affirms this election and again traverses the same. In particular, Applicant submits that the inventions defined by the various claims are so closely related that a Restriction Requirement is inappropriate. In particular, both of the groups of claims relate to communication apparatus and a communication method utilizing a communication apparatus which is connected to a terminal apparatus via a network wherein the apparatus includes a memory and a transmitter in both groups. Similarly for both groups of claims, the communication method includes storing of an address book and transmitting image data and the address book to a terminal apparatus. Accordingly, it is respectfully submitted that restriction is inappropriate between the above-noted groups of claims.

Additionally, Applicant submits that the Examiner has made no showing of a serious burden on the Examiner if the above-noted Restriction Requirement were not insisted upon. Further, Applicant submits that no such showing of serious burden can be made in the

present application and accordingly, for this additional reason, the Restriction Requirement is inappropriate.

Nevertheless, the Examiner issued an action on the merits of the claims elected during the provisional telephone election and withdrew the remaining claims from consideration in the present application.

In particular, in the outstanding Official Action, the Examiner rejected claims 20-31 and 39-49 under 35 U.S.C. § 102(e) as anticipated by RACHELSON (U.S. Patent No. 6,157,706). Applicant respectfully traverses the above rejection and submits that it is inappropriate.

Before setting forth the details of Applicant's basis for traversing the above rejections, Applicant wishes to make of record a person interview conducted on May 13, 2003. Present at the above-noted interview were Applicant's undersigned representative, Examiner Pokrzywa in charge of the present application, as well as Mr. Tsuchiya who represents the Assignee of the present application. During the above-noted interview, Applicant pointed out the shortcomings and deficiencies of the above-noted RACHELSON reference applied by the Examiner against all the claims in the present application. Applicant pointed out that RACHELSON does not teach the combination of features recited in Applicant's invention as will be set forth in further details hereinbelow. Applicant further discussed the details of

the proposed amendments to the claims which the Examiner indicated in the Interview Summary Form "would overcome the current art rejection".

The Examiner is respectfully thanked for his cooperation during the above-noted interview and for his assistance in clarifying the outstanding issues herein.

In interpreting the RACHELSON reference with respect to claim 20, the Examiner asserted that it discloses a communication apparatus in the form of administrative site 100 connected to a terminal apparatus comprising facsimile machines 110 and computer 120 via a network. The Examiner also noted that RACHELSON discloses an address book including a plurality of destination addresses that are stored as a structured document, making reference to Fig. 9 and column 8, lines 15-28.

Applicant respectfully traverses the above rejection and submits that it is inappropriate when considered with respect to the claims of the present application. In particular, Applicant's claim 20 now defines the address book as being stored in memory in the form of an HTML file. Further, claim 20 defines a communicator that transmits the address book to the terminal apparatus when a request for the address book is received from the terminal address and a controller that, in response to an instruction from the terminal apparatus, transmits at least one input screen to the terminal apparatus, the input screen being associated with the address book. Further, the input screen is configured so that the address book can be modified from the terminal apparatus.

By the present response, claims 57-59 are presented for consideration. It is submitted that these claims are patentable both for depending from a shown to be allowable claim as well as based upon their own respective recitations.

During the above-noted interview and as is obvious from the above-noted discussion of the disclosure of the RACHELSON reference that was relied upon by the Examiner, in the claimed combinations, at least an address book being stored as an HTML file is not disclosed therein and in addition, the input screen and the operation and structure thereof is also not taught, disclosed nor rendered obvious by the RACHELSON reference.

For each of the above reasons and certainly for all of the above reasons, it is respectfully submitted that the combination of features recited in Applicant's claim 20 as well as the combination of features recited in Applicant's claim 39 is not taught, disclosed nor rendered obvious by RACHELSON.

In this regard, while RACHELSON does disclose an address book and the data therein is changeable, it does not disclose at least the changing of the data in the address book in response to instructions from the terminal apparatus and certainly does not disclose an address book stored as an HTML file or the input screens and the other features of the controller and communicator recited in the combinations of Applicant's claims 20 and 39.

In particular, in RACHELSON, as set forth at column 2, lines 43-54, entries can be made in the user's address book in either one of two ways. An entry can be made when e-

mail is received from a sender for the first time and a user can make entries by calling a predetermined telephone number and responding to voice prompts. Thus, the combination of features recited in Applicant's claims 20 and 39 are clearly not taught, disclosed nor rendered obvious by the disclosure of RACHELSON.

Yet further, and as shown in Figs. 5-8, the changes to the address book are made using the "user telephone interface" which involves placing a voice call to a predetermined telephone number of an EPO (electronic post office). The flowchart for changes to the address book are set forth in RACHELSON Figs. 5-8, while the contents of the address book are shown in Fig. 9. As can be seen with respect thereto, there is no disclosure, teaching or suggestion in RACHELSON that changes to the address book of the communication apparatus can be made in response to an instruction from the terminal apparatus. Nor is there even a communicator that transmits the address book to the terminal apparatus from the communication apparatus when a request for the address book is received. In addition, the address book of RACHELSON is not stored as an HTML file. Finally, RACHELSON does not disclose at least one input screen associated with the address book which is configured so that the address book can be modified from the terminal apparatus.

For each of the above-noted reasons and certainly for all of the above-noted reasons, it is respectfully submitted that each of the claims in the present application is clearly patentable over the disclosure of RACHELSON. Accordingly, Applicant respectfully

requests reconsideration and withdrawal of the outstanding rejection together with an indication of the allowability of all the claims pending in the present application, in due course. Such action is respectfully requested and is now believed to be appropriate and proper.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has made of record a personal interview conducted in the present application. Applicant has amended the claims to more clearly define features of Applicant's invention and has submitted several additional claims for consideration.

Applicant has further discussed the operation of Applicant's invention with reference to the embodiment described in the disclosure. Applicant has discussed the disclosure of the reference and has pointed out the shortcomings thereof with respect to the features recited in Applicant's claims. Applicant has further reviewed the claim language and has shown the shortcomings of the reference with respect thereto. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully requests an indication to such effect in due course.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be

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considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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20. (Amended) A communication apparatus connected to a terminal apparatus via a network, the communication apparatus comprising:

 a memory that stores an address book including a plurality of destination addresses, the [destination addresses] address book being stored as a [structured document] HTML file;

 a transmitter that transmits image data to a designated destination address which is stored in the address book, the image data being transmitted via at least one of the network or a telephone network;

 a [server] communicator that transmits the [structured] address book to the terminal apparatus when a request for the address book is received from the terminal apparatus, the address book being displayable at the terminal apparatus; and

 a controller that [controls the address book to change a content of the address book in accordance with an instruction from the terminal apparatus], in response to an instruction from the terminal apparatus, transmits at least one input screen, associated with the address book, to the terminal apparatus, said input screen having an input field enabling modification of a destination address, said screen configured so that the address book can be modified from the terminal apparatus.

21. (Amended) The communication apparatus according to claim 20, wherein said controller deletes a designated destination address in the address book, in accordance with an instruction from the terminal apparatus.

22. (Amended) The communication apparatus according to claim 20, wherein said controller adds a destination address into the address book, in accordance with an instruction from the terminal apparatus.

23. (Amended) The communication apparatus according to claim 20, wherein said controller edits a designated destination address in the address book, in accordance with an instruction from the terminal apparatus.

24. (Amended) The communication apparatus according to claim 20, wherein the address book includes telephone numbers as the destination addresses.

27. (Amended) The communication apparatus according to claim 20, said server transmitting the [structured] address book and menu items to the terminal apparatus, wherein the [structured] address book and the menu items are displayed as single image at the terminal apparatus, the menu items being utilized to change a content of the address book.

39. (Amended) A communication method using a communication apparatus connected to a terminal apparatus via a network, comprising:

storing an address book including a plurality of destination addresses into a memory, the [destination addresses] address book being stored as [a structured document] an HTML file;

transmitting image data to a designated destination address stored in the address book, the image data being transmitted via at least one of the network and a telephone network;

transmitting the [structured] address book to the terminal apparatus when a request for the address book is received from the terminal apparatus, the address book being displayable at the terminal apparatus; and

controlling [the address book to change a content of the address book in accordance with an instruction from the terminal apparatus], in response to an instruction from the terminal apparatus, transmission of at least one input screen associated with the address book, to the terminal apparatus, the input screen having an input field enabling modification of the destination address, modification of the address book from the terminal apparatus being enabled by the input screen.

40. (Amended) The communication method according to claim 39, wherein the controlling deletes a designated destination address in the address book, in accordance with an instruction from the terminal apparatus.

46. (Amended) The communication method according to claim 39, further comprising transmitting the [structured] address book and menu items, wherein the

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[structured] address book and the menu items are displayed as single image at the terminal apparatus, the menu items being utilized to change a content of the address book.